

REMARKS/ARGUMENTS

Claims 1-12, 14, 15, 20, 21, and 25 and 26 are pending in the application and are subject to restriction. Applicants are herein amending claims 8 and 15.

Amendments to the Claims

Applicants are herein amending claims 8 and 15 to correct obvious typographical errors. Applicants respectfully submit that no new matter is introduced by the amendment and that the amendment to the claims is fully supported by the specification and claims, as originally filed.

Restriction Requirement

Claims 1-12, 14, 15, 20, 21, and 25 and 26 are pending in the application and are subject to restriction. under 35 U.S.C. § 121 as follows:

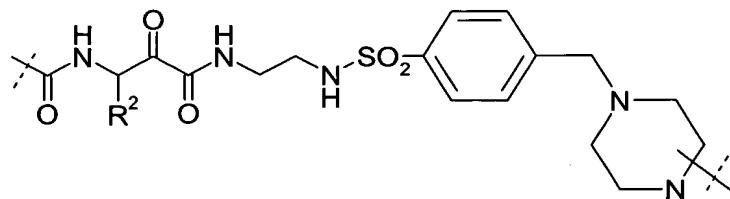
- I. Claims 1-12, 14, 15, and 25 in part, drawn to compounds wherein they have the formula given in Table 2, wherein W is a Ser, Pro, Leu containing, R is a nonheteroatom-containing ring and R² is Bn;
- II. Claims 1-12, 14, 15, and 25 in part, drawn to compounds and pharmaceutical compositions as given by formula in Table 2, wherein W is a Ser, Pro, Leu containing, R² is a Bn and R is a thienyl group attached to SO₂;
- III. Claims 1-12, 14, 15, and 25 drawn to compounds and compositions as given in the formula in Table 2, W is Ser, Pro, Leu containing R² is Bn and R is a pyridinyl;
- IV. Claims 1-12, 14, 15, and 25 drawn to compounds and compositions as given in the formula in Table 2, W is Ser, Pro, Leu containing R and R² is a other than in Groups I-III;
- V. Claims 20 and 21 drawn to compounds in Table 4, not included in Groups I-IV, wherein R hetero group is a morpholine;

- VI. Claims 20 and 21 drawn to compounds in Table 4, not included in Group I-IV wherein R hetero group is isoxazolyl;
- VII. Claims 20 and 21 drawn to compounds as given in Table 4, not included in Group I-IV wherein the hetero group is a keto piperidine;
- VIII. Claims 20 and 21 drawn to compounds in Table 4, not included in Group I-IV, wherein the R group does not include a heteroring;
- IX. Claims 20 and 21 in part drawn to compounds and composition, as given in Table 4, not included in Group I-IV, wherein the R heteroring is pyrrolidine;
- X. Claims 20 and 21 in part drawn to compounds as given in Table 4, not included in Group I-IV, wherein the R has a piperazine;
- XI. Claims 20 and 21 in part, drawn to compounds as given in Table 4, not included in Groups I-IV, wherein R is other than as given in Groups V to X; and
- XII. Claim 26 drawn to a method of treating, subject to further restriction.

The restriction requirement indicates that Group XII will be rejoined with any claims of Groups I-IV if any of the claims of these groups.

Applicants elect, with traverse, **Group X** for examination purposes only. Applicants request that Group XII be rejoined with Group X if the claims of Group X directed to compounds deemed patentable. Please note that the Office Action only indicates that rejoinder would apply to Groups I-IV, but applicants believe that the rejoinder would apply to any compound claims deemed patentable.

For purposes of carrying out the search and initial examination of the compounds of Group X, applicants present the following "subgeneric" core structure of Group X:



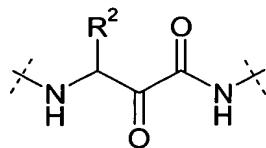
found in numerous examples within Tables 4 and 5. An example of the “subgeneric” core structure above is **Example 100**, found on page 41 of the application in Table 4. Claims 1, 2, 4-10, 12-14, 20, 21, 25, and 26 read thereon. It is emphasized that, applicants are submitting the subgeneric structure of the compounds of Group X for the sole purpose of facilitating the initial search and examination of the compounds of Group X, in accordance with MPEP § 803.02, and not in any way to restrict the scope of the generic claims of this application to such subgenera. Upon a finding of patentability of the subgenera, it is applicants’ understanding that the search will be extended to cover the entire scope of the compounds of Group X (and beyond, if the restriction requirement is removed or the number of groups reduced).

According to MPEP § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

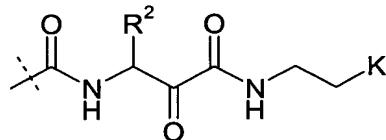
- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 to § 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 806.04(a) to § 806.04(i), § 808.01(a), and § 808.02).

For purposes of the initial requirement, a serious burden may be *prima facie* shown if the examiner shows separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. Applicants submit that a search may be conducted on a core structure further defined than alleged in the Office Action and thus would not constitute a serious burden.

More specifically, the compounds of Groups I-XI share a common core structure. As disclosed in claim 1, the compounds of the present invention share a substantial structural feature in the core of the molecules:



the structural feature being essential to the utility of all of the compounds. Applicants further submit that many of the compounds of the present invention share substantial structural similarity beyond the core of the molecule above, as demonstrated in Tables 2, 4, and 5, for example:



Applicants submit that the compounds of the present invention share a common utility – as calpain inhibitors – attributable to the structural core of molecule demonstrated by the biological results disclosed in Table 2-5. Applicants further submit that the utility of the compounds of the invention as calpain inhibitors is not limited in the specific scope of the definition of R (in Tables 2, 3, and 5) and, thus, R should not be the focus of a restriction requirement. Independent of substituent R, the compounds of the invention demonstrate similar operation, function and effect, not different operations, functions, and effects. Hence, applicants respectfully request reconsideration of the requirement for restriction and all the claims encompassed in the application be examined in a single application.

Applicant hereby reserves the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

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PATENT

Conclusions

For the above reasons, applicants respectfully request:

- (1) entry of the amendment to the claims; and
- (2) reconsideration and withdrawal of the requirement for restriction.

Respectfully submitted,



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